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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,427	12/21/2001	Pekka Koponen	4208-4072	5709
85775 7590 06/25/2009 Locke Lord Bissell & Liddell LLP Attn: IP Docketing Three World Financial Center New York, NY 10281-2101			EXAMINER ELALLAM, AHMED	
			ART UNIT 2416	PAPER NUMBER
			NOTIFICATION DATE 06/25/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptopatentcommunication@lockelord.com

### Office Action Summary

**Application No.**

10/032,427

**Applicant(s)**

KOPONEN ET AL.

**Examiner**

AHMED ELALLAM

**Art Unit**

2416

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-24 and 26-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-15, 17-24, 26-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This office action is responsive to Amendment filed on 11/04/2008. The Amendment has been entered. Claims 1-12, 14-15, 17-24, 26-39 are pending.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 27 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 27 and 38, claims 27 and 38 recite (inter alias): "A computer readable medium, comprising: a computer readable medium having computer executable program code therein". The meaning of a computer readable medium comprising a computer readable medium make no sense. (I.e. a memory comprising a memory). Therefore the meaning of claims 27 and 38 is indefinite.

Reference is made to "said computer readable medium", since there are two computer readable mediums, it is not clear to what medium is referred to. The meaning of these claims is confusing.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 10, 12-15, 17, 20, 26-30, 32, 33, and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al, US 2002/0071416 A1 in view of Schiffer, US 6,871,063. Hereinafter referred to as Carlson and Schiffer respectively..

Regarding claims 1 and 13, with reference to figure 1, Carlson discloses a first wireless device 114 (claimed first wireless communication device) and a second wireless device 124 (claimed mobile station) that communicates over a wireless communication link, wherein information content from a WAN 143 is transmitted to the first wireless device over the second wireless device, see paragraph [0032]-[00033].

Carlson also discloses, as an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053].

Regarding claim 15, with reference to figure 1, Carlson discloses a first wireless device 114 (claimed first wireless communication device), the first wireless device having a transmitter 118 and a second wireless device 124 (claimed mobile station) that communicates over a wireless communication link, wherein information content from a WAN 143 (claimed communication network) is transmitted to the first wireless device over the second wireless device, see paragraph [0032]-[00033].

A control unit is inherent to the first wireless communication device because it is required for controlling the device), (claimed control unit).

Carlson also discloses as, an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053].

Regarding claim 26, is a means claim having the same scope of claim 15, thus is subject to the same rejection.

Regarding claim 28, with reference to figure 1, Carlson discloses a first wireless device 114 (claimed first wireless communication device) requesting content from WAN 143 through a second wireless device 124 (claimed mobile station) that communicates over a wireless communication link, wherein information content from a WAN 143 is transmitted to the first wireless device over the second wireless device, see paragraph [0032]-[00033].

Carlson also discloses, as an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053].

Regarding claims 32 and 37, claims 32 and 37 are apparatus and means claims having the same scope of reverse steps of respective claims 1, thus they are subject to similar rejections.

Regarding claim 39, claim 39 is a system claim having the same scope of claim 1, thus it is subject to the same rejection.

**As to claims 1, 15, 26, 28, 32, 37, and 39:**

The difference between claims 1, 15, 26, 28, 32, 37, and 39 and the teaching of Carlson is that while Carlson discloses verifying using SIM information for content, it does not specify establishing and authenticating a connection using the SIM information of the first wireless device by the second wireless device.

However, Schiffer discloses in the same field of wireless short-range access to internet, using SIM information for establishing and authenticating a connection to the internet using received information at a mobile phone 100 (claimed mobile phone) from entered information of wireless computer system 110. See figure 1, abstract and column 4, lines 5-9.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method/apparatus/or system of Carlson by using subscriber identification data in requesting content through the second wireless communication device as taught by Schiffer in order to prevent intruders from access to Internet. It is also advantageous to implement the invention of Carlson to mobile stations having SIM modules capabilities so to adapt to established SIM standards authentication methods.

Regarding claim 2, with reference to figure 1, Carlson shows a WAN connection facility, wherein wireless link 147 is for connecting to WAN 143. (Claimed communication network is the closest network in which the mobile is arranged to operate).

Regarding claims 3, and 29, Carlson discloses a cellular network, see paragraph [0010].

Regarding claim 4, with reference to figure 1, Carlson shows the second communication device 124 is closer to the WAN 143 than the first communication device. Further the requested content by the first wireless device implies that the connection between the second wireless device and the WAN is identified on the basis of the requested content (i.e. destination IP address) transmitted from the first communication device. (Claimed mobile station second wireless communication device is closer to said communications network than said first wireless communication device, and a connection between said mobile station and the communications network is identified on the basis of data transmitted from the first wireless communication device).

Regarding claims 5, 6, 12, Carlson also discloses, as an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053]. (As to claim 12, the SIM is notoriously known for registration to own operator).

Regarding claim 10, as indicated in claim 1 above, requested content is delivered to the first wireless device via the second wireless device. (Claimed providing to said first wireless communication device a communications network service via said mobile station in which service an information content is transmitted via said communications network and said mobile station to the first wireless communication device).

Regarding claims 14 and 30, Carlson discloses that the first wireless device is a PDA, see paragraph [0026].

Regarding claims 17, 20 and 33, Carlson also discloses, as an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053]. (Claimed user identification data comprises an operator identifier).

Regarding claims 27 and 38, Carlson in view of Schiffer discloses a method step as discussed above with regard to claim 1. Carlson in view of Schiffer does not specify implementing the method using computer program product, comprising a computer readable medium having computer executable program code for performing the steps of the method. However, using computer program product for executing instructions for performing method steps is well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the method of Bhatia using executable instructions by a computer product so to reduce the cost and time of the hardware implementation resulting in more profitability.

3. Claims 7-9, 11, 18, 19, 21-24, 31 and 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carlson et al, US 2002/0071416 A1 in view of Schiffer, US 6,871,063 and further in view of Findikli et al, US 6,445,914. Hereinafter referred to as Findikli.



Regarding claim 21, with reference to figure 1, Carlson discloses a first wireless device 114 (claimed first wireless communication device), the first wireless device having a transmitter 118 and a second wireless device 124 (claimed mobile station) that communicates over a wireless communication link, wherein information content from a WAN 143 is transmitted to the first wireless device over the second wireless device, see paragraph [0032]-[00033].

Carlson also discloses, as an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053].

Regarding claim 34, with reference to figure 1, Carlson discloses a first wireless device 114 (claimed first wireless communication device) requesting content from WAN 143 through a second wireless device 124 (claimed mobile station) that communicates over a wireless communication link, wherein information content from a WAN 143 is transmitted to the first wireless device over the second wireless device, see paragraph [0032]-[00033]. The second wireless device comprising a transceiver 128 (claimed receiver in a mobile station).

Carlson also discloses, as an example, using a credit card number or a SIM (Subscriber identification module information) (claimed user identification data) to verify the payment information for requested content, see paragraph [0053].

The difference between claims 21 and 34 and the teaching of Carlson is that while Carlson discloses verifying using SIM information for content, it does not specify

establishing and authenticating a connection using the SIM information of the first wireless device by the second wireless device.

However, Schiffer discloses in the same field of wireless short-range access to internet, using SIM information for establishing and authenticating a connection to the internet using received information at a mobile phone 100 (claimed mobile phone) from entered information of wireless computer system 110. See figure 1, abstract and column 4, lines 5-9.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the method/apparatus/or system of Carlson by using subscriber identification data in requesting content through the second wireless communication device as taught by Schiffer in order to prevent intruders from access to Internet. It is also advantageous to implement the invention of Carlson to mobile stations having SIM modules capabilities so to adapt to established SIM standards authentication methods.

In addition, Carlson in view of Schiffer do not specify the second wireless device is configured to receive user identification data from a user data identification module comprising user identification data of the user of the first wireless communication device.

However, Findikli discloses as part of prior art in the global system for mobile communications (GSM) using removable subscriber identity module (SIM) card. See column 1, lines 24-25.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the removable SIM card feature in the second wireless device of Carlton so that the invention of Carlton in view of Schiffer can be used in the GSM system networks. The advantage would be the ability to download requested content by the first wireless device using the second wireless device in the GPS system in compliance with standard protocols.

Regarding claims 22 and 35, Findikli further discloses cellular operator typically purchases a supply of SIM cards to be provided to subscribers. (Claimed user data identification module is a module of a first operator, with the aid of which module the first wireless communication device can register, via said mobile station -to a network operated by said first operator).

Regarding claims 7-9, 18, 19, 23-24 and 36:

Carlson, as discussed above, with reference to figure 1 discloses a first wireless device 114 communicating over a second wireless device 14, the first wireless device communicates with a WAN (Wide Area Network) over the second communication device, wherein the link between the first wireless device and the second communication device is a short-range radio link. Carlson also discloses the first wireless device comprising a SIM module, see paragraph [0033].

Carlson in view of Schiffer do not specify the second wireless device is configured to receive user identification data from a user data identification module comprising user identification data of the user of the first wireless communication device.

However, Findikli discloses as part of prior art in the global system for mobile communications (GSM) using removable subscriber identity module (SIM) card. See column 1, lines 24-25.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the removable SIM card feature in the second wireless device of Carlton so that the invention of Carlton in view of Schiffer can be used in the GSM system networks. The advantage would be the ability to download requested content by the first wireless device using the second wireless device in the GPS system in compliance with standard protocols.

Regarding claims 11 and 31, Findikli discloses SIM cards are conventionally pre-programmed to include the IMSI. (Claimed User identification data of the first wireless communication device comprises at least one of the following: IMSI (International Mobile Subscriber Identity) code, IMUI (International Mobile User Identity) code).

### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-15, 17-24, 26-39 have been considered but are moot in view of the new ground(s) of rejection.

#### **35 USC § 112**

35 USC § 112 1st paragraph have been withdrawn in view of the Amendment to claims 27 and 38. New ground of rejection has been introduced.

#### **35 USC § 103:**

**Claims 1-6, 10, 12-15, 17, 20, 26-30, 32, 33, and 37-39:**

Applicant argues on page 19 that:

*"Carlson does not disclose the Applicant's claimed receiving at a mobile station user identification data of a first communication device over a wireless local link. Carlson also does not disclose the Applicant's claimed establishing and authenticating connection from the mobile station to the mobile station's own communications network using the received user identification data of said first wireless communication device. Contrary to the Examiner's remarks paragraph [0053] in Carlson does not disclose user identification data. The SIM mentioned therein is not a "subscriber identity module", but instead is a "system information module" (see Carlson, paragraph [0038]). There is no disclosure or suggestion in Carlson that his "system information module" would contain user identification data. There is no disclosure or suggestion in Carlson that this information would be transferred between the first communication device and the mobile station in order to establish and authenticate another connection". Emphasis added.*

Examiner respectfully disagrees, with Applicant argument, as indicated above rejections. Carlson solves the same problem of access to data content over a short wireless range, which is similar to that of Applicant's disclosure. Carlson as an example discloses, using a credit card number or a SIM (System identification module information) which correspond to Applicant SIM (claimed user identification data) to verify the payment information for requested content, see paragraph [0053]. A person of skill in the art would equate the SIM of Carlson with the known SIM (subscriber

identification module). It should be noted that Applicant did not invent the SIM, and SIM card are widely used internationally at the time of the invention.

Nevertheless, for the sake of argument, even if it is assumed that the Carlson SIM is not a subscriber identification module (as Applicant contends), the complementary teaching of Schiffer which is also in the same field of wireless short-range access to internet, which uses SIM information for establishing and authenticating a connection to the internet using received information at a mobile phone 100 (claimed mobile phone) from entered information of wireless computer system 110. See figure 1, abstract and column 4, lines 5-9.

Schiffer discloses as Applicant pointed out on page 20:

"For one embodiment, a **short-range**, wireless communication link, such as a Bluetooth link, **is established** between a mobile phone and a computer system. The mobile phone transmits **an access code** via the link to the computer system. The access code is generated using data stored in the **subscriber identity module (SIM)** in the mobile phone. Access to the computer system is granted in response **to receiving the access code**. In this manner, **the SIM is used not only to identify the user during cellular phone calls (or other long-range, wireless communication) but also to authenticate the user and to gain access to a computer system**".

From the above, Gaining access correspond to establishing.

Applicant further argues that *"Schiffer does not disclose or suggest the Applicant's claimed 'establishing and authenticating connection from the mobile station to the mobile station's own communications network using the received user*

*identification data of said first wireless communication device". Schiffer's "data stored in the subscriber identity module (SIM)" is the data identifying Schiffer's mobile phone 100, itself. There is no other SIM information from another wireless device".* Emphasis added.

Examiner respectfully disagrees, attention is directed to the previous passage of Schiffer.

**Claims 7-9, 11, 18, 19, 21-24, 31 and 34-36:**

Applicant alleged that Findikli does not disclose or suggest the Applicant's claimed "establishing and authenticating connection from the mobile station to the mobile station's own communications network using the received user identification data of said first wireless communication device".

Examiner respectfully disagrees, Findikli was not cited as an anticipating reference to be addressed as not teaching establishing and authenticating connection from the mobile station to the mobile station's own communications network. Those limitations are already addressed by Carlson and Schiffer.

As indicated above, Schiffer discloses in the same field of wireless short-range access to internet, using SIM information for establishing and authenticating a connection to the internet using received information at a mobile phone (See figure 1, abstract and column 4, lines 5-9). Using the teaching of Schiffer with that of Carlson by using subscriber identification data in requesting content through the second wireless communication device ( as taught by Schiffer) in order to prevent intruders from access to Internet. Findikli in the other hand discloses as part of prior art in the global system

for mobile communications (GSM) using removable subscriber identity module (SIM) card. See column 1, lines 24-25. Therefore, it can be obvious to introduce the removability feature of the SIM in the system of Carlton in view of Schiffer to comply with established standards, and to download requested content by the first wireless device of Carlton/Schiffer using the second wireless device of Carlton/Schiffer in the GPS system.

Examiner believes that the rejections are to be maintained as been proper.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to AHMED ELALLAM whose telephone number is (571)272-3097. The examiner can normally be reached on 7-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chi H. Pham can be reached on (571) 272-3179. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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